

### REMARKS

Claims 1-2, 5-8, 10, 12-13, 16-17, 23-34, and new claim 35 are pending in this application. In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claim 1 has been amended to include subject matter indicated by the Examiner to be allowable. In addition, new independent claim 35 has been added to recite features of independent claim 23 and dependent claim 27.

As no new matter has been added by the amendments herein, Applicant respectfully requests entry of these amendments at this time.

### ALLOWABLE SUBJECT MATTER

The Examiner has indicated that claims 3-4, 27, and 32 would be allowable if rewritten in independent form. In response, Applicant has rewritten claim 1 to include the subject matter indicated to be allowable, i.e., claims 3 and 4, but have also included subject matter recited in claims 27 and 32, which was indicated to be allowable by the Examiner, and amended the claim to remove the thickness of the intermediate layer and the dual cover layer. In addition, new independent claim 35 has been added to reflect substantially the same subject matter indicated to be allowable in claim 27.

### THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

Claims 1-2, 10, 12-13, 16-17, 23-26, 29-31, and 34 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,730,665 to Shimosaka *et al.* for the reasons set forth on pages 2-3 of the Office Action. In addition, claims 5-8, 28, and 33 have been rejected under § 103(a) as obvious over Shimosaka in view of U.S. Patent No. 6,015,356 to Sullivan for the reasons provided on page 3 of the Office Action. Applicant respectfully disagrees with these rejections for the same reasons outlined in the previous responses filed January 2, 2003 and July 21, 2003, which are incorporated by reference herein in their entirety.

### *Shimosaka '665 Does Not Disclose or Suggest the Staged Resin Film of the Present Invention*

With regard to independent claim 1, and those claims depending therefrom, Shimosaka '665 is completely silent as to a golf ball intermediate layer formed from a staged resin film.

Further, Shimosaka '665 does not disclose or suggest an intermediate layer formed from a staged resin film that includes at least one of a partially or totally blocked isocyanate, interpenetrating polymer network, or a ketimine bond derived from a ketone or an aldehyde and an amine having a branched carbon atom or a ring member carbon atom bond at the X-position. As such, Shimosaka '665 does not anticipate the present invention recited in independent claim 1.

With regard to independent claims 23 and 30, the Examiner is of the opinion that the language following the "wherein" clause is indicative of a method of making the staged resin film and, therefore, is not relevant to the final product. Applicant respectfully disagrees. The claims do not recite a method of making the staged resin film of the present invention, but instead describe the state or condition of the staged resin film. In other words, "wherein the thermosetting staged resin film is partially cured," as recited in independent claim 23, indicates that the staged resin film is in a partially cured state. This is similar to reciting whether a component is a solid, liquid, or a gas.

Furthermore, because the film is in a partially cured state, it has a hardness that is 10 percent to 80 percent of a film that is completely cured. As such, Applicant respectfully submits that the state of the staged resin film is highly relevant to the claim and cannot be ignored as if it was a product by process claim.

Even if the claim language was interpreted to be a product by process, *arguendo*, the structure implied by the process steps should be considered when assessing the patentability of the claims over the cited references (MPEP § 2113). The "structure" in the claim is the golf ball component formed of the partially cured staged resin film. Shimosaka '665 does not even suggest such a golf ball component.

And, because the staged resin film is in a partially cured state, the golf ball component recited therein remains tacky or sticky to the touch. In contrast, however, the main objective of Shimosaka '665 is a "smooth mold release" (as discussed in detail in the Response to Office Action filed on January 2, 2003). As such, a skilled artisan would not have been motivated to modify Shimosaka '665 to use a tacky or sticky material as a mold release. See MPEP § 2143.01 at 2100-124-125 ("If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.").

For at least these reasons, Applicant respectfully submits that Shimosaka '665 does not disclose or even suggest the present invention. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection based thereon.

*Sullivan Does Not Remedy the Deficiencies of Shimosaka '665*

As discussed above, Shimosaka '665 is deficient with respect to the present invention in that it does not disclose or even suggest the staged resin film of the present invention. In particular, Shimosaka '665 is completely silent as to a material that is used for a golf ball component that is in a partially cured state. Sullivan does not even suggest the use of a staged resin film, as presently recited, but instead is relied on by the Examiner only for its disclosure of heavy weight fillers in the inner cover (see Office Action at Page 3). Thus, one of ordinary skill in the art would not have had any motivation to combine the two references in order to arrive at the present invention.

As such, Applicant respectfully submits that no combination of Shimosaka '665 or Sullivan renders the present invention obvious. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection based thereon.

**CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicant invites the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including April 6, 2004. A Fee Sheet Transmittal is also submitted herewith to pay for the additional independent claim added. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0096.

Respectfully submitted,  
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP

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By: \_\_\_\_\_  
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